

REMARKS

Applicant thanks the Examiner for the thorough examination of the application. No new matter is believed to be added to the application by this Amendment.

Status of the Claims

Claims 1-22 are pending in the application. Claims 5-12 and 15-17 have been withdrawn from consideration by the Examiner. Claims 1-4, 13, 14 and 21 are rejected. Claims 18-20 are objected to. Claims 18 and 19 have each been amended to stand as independent claims by incorporating the subject matter of claim 1.

It should be noted that although claims 1-22 are pending in the present application, the Examiner has incorrectly indicated that claims 1 to 21 are pending.

Rejection Under 35 U.S.C. 103(a) Over Applicant's Disclosure in View of Kamimura

Claims 1-4 and 13-14 are rejected under 35 U.S.C. 103(a) as being obvious over Applicant's disclosure as set forth in Figures 1 and 2 in view of Kamimura (JP 2000-275629). Applicant traverses this rejection and respectfully requests reconsideration and withdrawal thereof.

The Examiner improperly uses the Applicant's own work set forth in the disclosure for teachings pertaining to elements of a liquid crystal display. The related art liquid crystal displays discussed in the specification are presented to show the disadvantages of the conventional art liquid crystal displays. There is no admission in the specification that these related art liquid crystal displays are prior art to the invention. Therefore, the Examiner's use of the Applicant's disclosure as prior art is improper.

The inability to utilize the disclosure without an admission as to prior art is well known. Most recently, the necessity for an applicant to admit prior art for an Examiner to utilize the disclosure as prior art has been set forth in Riverwood International Corporation v. R.A. Jones & Co., Inc., 343 F.3d 1346, 66 USPQ2d 1331 (CAFC March 31, 2003). For the Examiner's convenience, the relevant portion of Judge Linn's decision is set forth below:

This court and its predecessor have held that a statement by an applicant during prosecution identifying certain matter not the work of the inventor as "prior art" is an admission that the matter is prior art. In re Nomiya, 509 F.2d 566, 571 n.5, 184 USPQ 607, 611 n.5 (CCPA 1975). In Nomiya, the applicants filed a patent application containing two figures labeled as "prior art" and

described as such in the specification. Id. at 570-71, 184 USPQ at 611. The examiner rejected the pending claims as obvious over a U.S. patent in light of the two figures. Id. The applicants argued that the figures could not constitute prior art absent a statutory basis in section 102. This court's predecessor disagreed: "By filing an application containing Figs. 1 and 2, labeled prior art, ipsissimis verbis, and statements explanatory thereof appellants have conceded what is to be considered as prior art in determining obviousness of their improvement." Id. at 571, 184 USPQ at 611-12 (footnote omitted). Similarly, in Fout [675 F.2d 297, 300, 213 USPQ 532, 535 (CCPA 1982)], an applicant's admission of actual knowledge of the prior invention of another, which was described in the preamble of a Jepson claim, was held to constitute an admission that the described invention was prior art to the applicant. 675 F.2d at 301, 213 USPQ at 534.

While Nomiya and Fout stand for the proposition that a reference can become prior art by admission, that doctrine is inapplicable when the subject matter at issue is the inventor's own work. In In re Ehrreich, 590 F.2d 902, 200 USPQ 504 (CCPA 1979), the examiner considered material from the preamble of a Jepson claim as prior art when making an obviousness rejection. Id. at 909-10, 200 USPQ at 510. The Ehrreich court found that rather than making an admission about the scope and content of the prior art, the applicant used Jepson language to avoid a double patenting rejection in the applicant's co-pending application. Id., 200 USPQ at 510. That co-pending

application was not available to the public, was not the work of another, and was therefore not prior art under any statutory provision. The court concluded: "We think that a finding of obviousness should not be based on an implied admission erroneously creating imaginary prior art. That is not the intent of § 103." Id., 200 USPQ at 510.

In Reading & Bates Construction Co. v. Baker Energy Resources Corp., 748 F.2d 645, 223 USPQ 1168 (Fed. Cir. 1984), this court again considered an obviousness challenge to a patent in which certain claims referred to the patentee's own patent in both the specification section entitled "Summary of the Prior Art" and in the preamble to a Jepson claim. The Reading & Bates court held that the reference in the Jepson claim preamble to the applicant's own prior work was not prior art, citing the reasoning and policy of Ehrreich that "the preamble, standing alone, was not an admission that one's own prior work is prior art." Id. at 649, 223 USPQ at 1171. It also held that the patentee's discussion of his own patent in the specification section entitled "Summary of the Prior Art" did not constitute an admission that the patent was prior art. In reaching its conclusion, the court reviewed our precedent and recognized the "policy behind requiring a statutory basis before one's own work may be considered as prior art." Id. at 650, 223 USPQ at 1171 (citing In re Fout, 675 F.2d 297, 213 USPQ 532).

[T]here is an important distinction between the situation where the inventor improves upon his own invention and the situation where he

improves upon the invention of another. In the former situation, where the inventor continues to improve upon his own work product, his foundational work product should not, without a statutory basis, be treated as prior art solely because he admits knowledge of his own work. It is common sense that an inventor, regardless of an admission, has knowledge of his own work. Id. 223 USPQ at 1172. Riverwood at 66 USPQ2d 1354-1355.

The Court then concludes that "the present case does not involve a Jepson preamble of an explicit reference in the specification to the prior art... one's own work may not be considered prior art in the absence of a statutory basis and a patentee should not be punished for being as inclusive as possible...." Riverwood at 66 USPQ2d 1355.

Although a reference can, as a result, become prior art by admission, prior art cannot be alleged when the subject matter at issue is the inventor's own work, as the Court in Riverwood interprets Nomiya, Fout, Ehrreich and Reading & Bates. In the instant invention there is indeed no clear delineation between the old and new of the inventor's work, such as in a Jepson claim. Here, the inventor merely describes the problem to be solved.

The Examiner then turns to Kamimura for teachings pertaining to black matrices. Figure 1 of Kamimura shows a black matrix formed on an upper part of a lower substrate 1, and a polarizing plate 7 is formed on a lower part of the substrate 1.

Kamimura fails to teach that a polarizer is formed from a cholesteric liquid crystal. Kamimura further fails to address the inability of the Applicant's disclosure to be used to allege prior art. Even if it assumed *arguendo* that Kamimura can be combined with the Applicant's disclosure, this improper combination would still fail to fairly suggest a claimed embodiment of the invention.

As has been shown, the Applicant's disclosure and Kamimura, even if they could be combined, would fail to motivate a person having ordinary skill in the art to produce the invention as is embodied in independent claim 1. Thus a case of *prima facie* obviousness has not been made over claim 1. Claims dependent upon claim 1 are patentable for at least the above reasons alone. Accordingly, this rejection is overcome and withdrawal thereof is indicated.

Allowable Subject Matter

The Examiner has acknowledged allowable subject matter in claims 18-20. Claims 18 and 19 have been amended to stand as independent claims so as to make claims 18-20 instantly allowable.

Drawings

The Examiner is respectfully requested to indicate whether the drawing figures are acceptable.

SEARCH

Applicant assumes the Examiner has performed an adequate search of the prior art in accordance with Chapter 900 of the MPEP.

Conclusion

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Robert E. Goozner, Ph.D. (Reg. No. 42,593) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

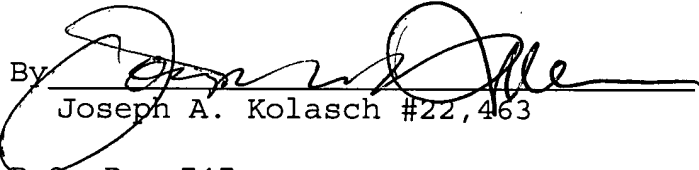
Attached hereto is a marked-up version of the changes made to the application by this Amendment.

Appl. No. 09/801,645

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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Attachments: Version with Markings to Show Changes Made

(Rev. 02/20/02)

VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE CLAIMS:

Claims 18 and 19 have been replaced with the following rewritten claims:

18. (Amended) [The liquid crystal display device according to claim 1,] A liquid crystal display device, comprising:

first and second substrates facing and spaced apart from each other;

a liquid crystal layer interposed between the first and second substrates;

a first polarizer formed under the second substrate and on the opposite side relative to the liquid crystal layer, the first polarizer being made of cholesteric liquid crystal;

color filters formed on the second substrate and facing the first substrate, wherein each color filter has one of a plurality of primary colors;

a black matrix formed in the boundaries between the color filters, wherein the black matrix is on the second substrate, and wherein the black matrix is made of the same material as the first polarizer; and

a backlight device arranged under the second substrate,

wherein the first polarizer reflects right-handed circularly polarized light and the black matrix reflects left-handed circularly polarized light.

19. (Amended) [The liquid crystal display device according to claim 1,] A liquid crystal display device, comprising:

first and second substrates facing and spaced apart from each other;

a liquid crystal layer interposed between the first and second substrates;

a first polarizer formed under the second substrate and on the opposite side relative to the liquid crystal layer, the first polarizer being made of cholesteric liquid crystal;

color filters formed on the second substrate and facing the first substrate, wherein each color filter has one of a plurality of primary colors;

a black matrix formed in the boundaries between the color filters, wherein the black matrix is on the second substrate, and wherein the black matrix is made of the same material as

the first polarizer; and

a backlight device arranged under the second
substrate,

wherein the first polarizer reflects left-handed circularly polarized light and the black matrix reflects right-handed circularly polarized light.